

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claims 1-10 were pending in this application when examined.

Claim 1 is amended to recite "a light-stabilizing effective amount of 0.2 w/v% or more".

Support for this amendment can be found on page 5, lines 17-21 of the specification.

Claim 2 is amended to correspond with the amendment to claim 1.

Support for new claim 12 can be found on page 5, lines 10-15 of the specification.

Support for new claim 13 can be found on page 2, lines 26-33 and page 4, lines 2-5 of the specification.

I. Declaration

The Declaration filed on January 5, 2009 has been considered, but the Examiner states that the evidence submitted in support of unexpected results is not found persuasive, because the exemplified preparations are not commensurate in scope with the claims. Claim 1 is amended to recite "a light-stabilizing effective amount of 0.2 w/v% or more". Thus, claim 1 now includes a specific light-stabilizing effective amount.

Accordingly, the showing of unexpected results is commensurate in scope with the claims.

II. Claim Rejection Under 35 U.S.C. § 112

The Examiner rejects claims 1-10 under 35 U.S.C. § 112, first paragraph, because the specification, **while enabling for** an aqueous liquid preparation comprising, in an aqueous solution, (S)-4-[4-[(4-chlorophenyl)-(2-pyridyl)-methoxy]-piperidino]-butanoic acid or a pharmaceutically acceptable acid addition salt thereof, and a low molecular weight water-soluble metal chloride in a light-stabilizing effective amount of **0.2% or more**, does not reasonably provide enablement for preparations comprising any water-soluble metal chloride in a light-stabilizing effective amount of less than 0.2%, or any high molecular weight water-soluble metal chlorides.

Claim 1 is amended to recite “a water-soluble metal chloride in a light-stabilizing effective amount of **0.2 w/v% or more**”, and, as acknowledged by the Examiner, the specification is enabling for “0.2 w/v% or more”.

Moreover, Experimental Example 1 in the present specification shows that Formulation 2, containing 0.1% of sodium chloride, forms a precipitate, and Formulation 3, containing 0.2% of sodium chloride, is stable with no change from the time of preparation (see page 7, line 21 – page 8, line 15). Thus, one of ordinary skill in the art would be capable of making and using the claimed aqueous liquid preparation without undue experimentation.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Claim Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Kita et al. (U.S. 6,307,052) (“Kita”) and Stevenson et al. (U.S. 4,053,628) (“Stevenson”). As applied to the amended claims, Applicant respectfully traverses the rejection.

One of ordinary skill in the art would not have been motivated to combine the teachings of the references, as suggested by the Examiner.

Kita discloses benzenesulfonate (bepotastine), and discloses a benzoate of an optically-active piperidine derivative, (+)-(S)-4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]piperidino] butylic acid.

Stevenson discloses, for example, that Antazoline and diphenhydramine can be optionally added as anti-histamine compounds (see col. 3, lines 14-16). Bepotastine, which is used in the present application, is a **piperidine derivative** (see Kita, Abstract, and enclosed Merck Index, item 1149). However, the two anti-histamine compounds disclosed in Stevenson (Antazoline and diphenhydramine) do not have a piperidine skeleton (see Merck Index, item 680 and item 3309).

Those having ordinary skill in the art consider compounds with different chemical structures to have different physical properties, even when the compounds have the same pharmacological effects. Accordingly, one of ordinary skill in the art would consider bepotastine to have different physical properties from those of Antazoline and diphenhydramine, because bepotastine is a piperidine derivative and Antazoline and diphenhydramine are not piperidine derivatives.

Moreover, the goal of the present invention is to solve the light instability problem associated with bepotastine, such as coloring and precipitation (see specification, page 1, line 30 – page 2, line 2). Stevenson does not describe a problem related to the light-stabilization of anti-histamine compounds, and the reference does not teach or suggest that metal chlorides contribute to light-stabilization.

In addition, Stevenson describes that 0.25-5% of an additive can be used, such as glycerin (see col. 3, lines 59-67, and col. 4, lines 1-2). **However, in Experimental Examples 1-4 of the present application, Formulations 8, 9 and 13-17 showed no light-stabilizing effect of bepotastine by the addition of 0.5-2.2% of glycerin. A light-stabilizing effect of bepotastine was observed only with water-soluble metal chloride.**

Furthermore, the Examiner has combined the references based upon impermissible hindsight analysis. Stevenson discloses an eye-drop solution containing cromoglycate and sodium chloride in Examples 1 and 3. However, the reference merely discloses one of the three types of water-soluble metal chlorides for which the light-stabilizing effect of bepotastine was clearly observed in the Experimental Examples of the present application.

The reference does not teach or suggest that water-soluble metal chlorides can be used in a light-stabilizing effective amount with a preparation comprising bepotastine. It would not have been obvious to one of ordinary skill in the art that only a water-soluble metal chloride, among many additives disclosed in Stevenson, has a light-stabilizing effect on bepotastine, absent Applicant's claims.

Accordingly, the Examiner has combined the references solely using Applicant's claims as a roadmap, which is clearly improper.

In view of the foregoing, claim 1 would not have been obvious over Kita in view of Stevenson.

Claims 2-10 depend directly or indirectly from claim 1, and thus also would not have been obvious over the references.

IV. New Claims

Claim 12 depends from claim 1, and is thus distinguished over the references for the reasons discussed above with respect to claim 1.

Claim 13 is directed to an aqueous eye drop comprising (+)-(S)-4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]piperidino]butyric acid or a pharmacologically acceptable acid addition salt thereof, which is light-stabilized with a water-soluble metal chloride at not less than 0.2 w/v%. It is distinguished over the cited references, because one of ordinary skill in the art would not have been motivated to combine the references to arrive at the aqueous eye drop of claim 13 for the reasons discussed above with respect to claim 1.

Accordingly, prompt examination and allowance of claims 12-13 are respectfully requested.

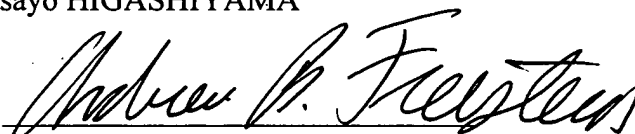
V. Conclusion

For these reasons, Applicant takes the position that the presently claimed invention is clearly patentable over the applied references.

Therefore, in view of the foregoing amendments and remarks, it is submitted that the rejections set forth by the Examiner have been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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Enclosure: The Merck Index, pages 110-111, 188-189 and 560-561 (2006)

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